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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/579,680      | 05/17/2006  | Koji Fujimoto        | 24530-015           | 9616             |

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COWAN, LIEBOWITZ & LATMAN, P.C.  
1133 AVENUE OF THE AMERICAS  
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| EXAMINER |
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AYCHILLHUM, ANDARGIE M

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| ART UNIT | PAPER NUMBER |
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2841

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| MAIL DATE | DELIVERY MODE |
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10/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |   |                                       |  |
|------------------------------|---|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/579,680      | <b>Applicant(s)</b><br>FUJIMOTO, KOJI |  |
|                              | <b>Examiner</b><br>ANDARGIE M. AYCHILLHUM | <b>Art Unit</b><br>2841               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 33-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/15/2006</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 18-32, drawn to surface mount composite electronic component, classified in class 174, subclass 259+.
  - II. Claims 33-34, drawn to a method of manufacturing a surface mount, classified in class 28, subclass 832+.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case: the product as claimed can be made by another and materially different process such as all of the surfaces of the insulating substrate other than the both side surfaces of the insulating substrate being a surface facing a circuit board.
4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

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because the inventions require a different field of search (see MPEP § 808.02),  
restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given  
above and there would be a serious burden on the examiner if restriction is not required  
because the inventions require a different field of search (see MPEP § 808.02),  
restriction for examination purposes as indicated is proper.

During a telephone conversation with Mark Montague on 9/24/08 a provisional  
election was made without traverse to prosecute the invention of Group I, claims 1-32.  
Affirmation of this election must be made by applicant in replying to this Office action.  
Claims 33-34 withdrawn from further consideration by the examiner, 37 CFR 1.142(b),  
as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention,  
the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more  
currently named inventors is no longer an inventor of at least one claim remaining in the  
application. Any amendment of inventorship must be accompanied by a request under  
37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public  
use or on sale in this country, more than one year prior to the date of application for patent in the United  
States.

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6. Claims 18-32 are rejected under 35 U.S.C. 102(b) as being by anticipated by Ginn et al. (US 6,097,277).

**Pertaining to claim 18**, Ginn et al. discloses a circuit element (26, see figs. 1-3) formed on a pair of opposed surfaces (see figs. 1-2) of an insulating substrate (12, see figs. 1-2) composed of a hexahedron (see figs. 1-2, with six faces) comprising electrodes (15, 14) that make up the circuit element (26) which also function as external terminals.

**Pertaining to claims 19 and 27**, Ginn et al. discloses wherein the circuit element (26) is composed of electrodes (15, 14) as well as resistors (26) or dielectrics that contact said electrodes (14, 15), a nickel plate layer and a solder plate (18) layer laid down, in that order, on the surfaces of external terminal areas of said electrodes (see figs. 1-2).

**Pertaining to claims 20 and 28**, Ginn et al. discloses wherein one surface of the insulating substrate (12) is substantially perpendicular to an adjacent surface (see figs. 1-2).

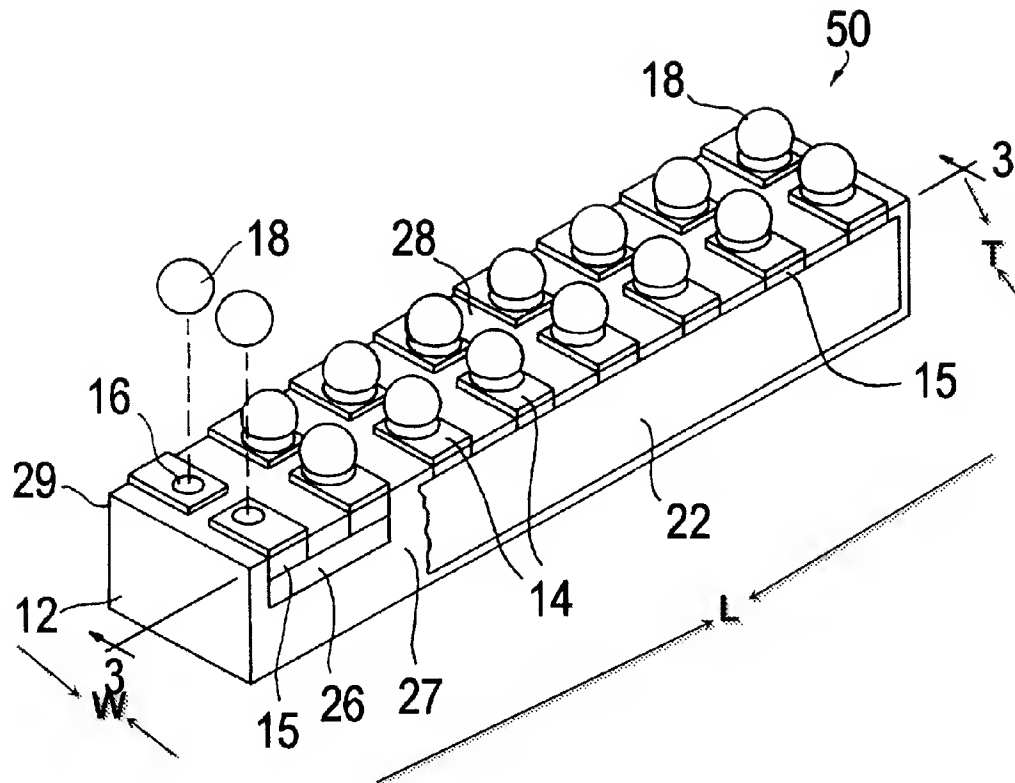
**Pertaining to claim 21 and 29**, Ginn et al. discloses having an area in which no electrodes are present on an edge portion (see figs. 1-3) of the surface of the insulating substrate (12) on which said external terminals (see fig. 1-3) are present, disposed

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perpendicular to a straight line connecting a pair of external terminals electrically connected (column 3, lines 1-16) to one circuit element (26).

**Pertaining to claims 22 and 30**, Ginn et al. discloses having an area in which the electrodes (15, 14) and the resistor (26) overlap and contact each other on the surface of the insulating substrate (12), the resistor (26) disposed on the insulating substrate (12) in said area, and further, the electrodes laid on the resistor (26, see figs. 1-13).

**Pertaining to claims 23 and 31**, Ginn et al. discloses wherein a relation between an insulating substrate (12) dimension (L) (see fig. below) in a direction of flow of electric current of the circuit element (26) of the insulating substrate (12) surface on which circuit elements (26) are formed, an insulating substrate (12) dimension (T) (see fig. below) perpendicular to L (see fig. below), and a distance (W) (see fig. below) between surfaces of the insulating substrate (12) on which the circuit elements (26) are formed is  $L \geq W > T$ , (see fig. below).



**Pertaining to claims 24 and 32,** Ginn et al. discloses wherein the electrodes (15, 14) that also function as external terminals (see fig. above) are also present on a surface of the insulating substrate (12) adjacent to the surface of the insulating substrate (12) on which the circuit elements (26) are present.

**Pertaining to claim 25,** Ginn et al. discloses a pair of first electrodes (14, 15) disposed on both ends of a front surface of an insulating substrate (12) composed of a hexahedron (see fig, above with six faces) and a first shared electrode (14) disposed between and separate from said first electrodes (14); a pair of second electrodes (15) disposed on a rear surface of the insulating substrate (12) opposite the first electrodes (14) and a second shared electrode (15) disposed between and separate from said

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second electrodes (15); two first resistors (26) disposed so as to contact the first pair of electrodes (15) and the first shared electrode (14); and two second resistors (column 3, lines 4-16) disposed so as to contact the second pair of electrodes (15) and the second shared electrode (14).

**Pertaining to claim 26**, Ginn et al. discloses wherein the number of external terminals is six (14, see fig. above).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDARGIE M. AYCHILLHUM whose telephone number is (571) 270-1607. The examiner can normally be reached on (Mon-Fri from 8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy C. Norris/  
Primary Examiner, Art Unit 2841

A.A.  
September 24<sup>th</sup>, 2008